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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/874,630 | 06/04/2001 | Gary E. Sullivan | 258/278 | 3402 |
| 30408 | 7590 | 08/25/2006 | EXAMINER | |
| GATEWAY, INC. ATTN: PATENT ATTORNEY 610 GATEWAY DR. MAIL DROP Y-04 N. SIOUX CITY, SD 57049 | | | KANG, PAUL H | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2144 | |
| DATE MAILED: 08/25/2006 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|---------------------------------|-------------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/874,630 | SULLIVAN ET AL. | |
| | Examiner Paul H. Kang | Art Unit 2144 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 02 June 2006.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-44 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-44 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 04 June 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 5-8, 12-15, 18, 20, 22-23, 25-26, 28-30, 32-33, 35-7, 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appleby, US Patent No. 6,463,404 in view of Morimoto et al. (Morimoto), US Patent No. 6,789,057.

3. As per claims 1, 20 and 26, Appleby discloses the invention substantially as claimed. Appleby discloses in a computer network comprising a client computer and a plurality of servers, wherein each server is capable of being assigned at least one conversion rating, each conversion rating corresponding to a first file format unreadable by the client computer, a method for selecting one of the plurality of servers comprising: receiving a file on the client computer, wherein the file is written in a source format unreadable by the client computer [see Appleby, col. 3, lines 42-67 and col. 4, lines 1-49]. However, Appleby does not explicitly disclose selecting one of the plurality of servers having the highest conversion rating assigned thereto corresponding to the source format of the received file.

In the same field of endeavor, Morimoto discloses (e.g., information processing apparatus connected to a network to translate a document). Morimoto discloses selecting one of the plurality of servers having conversion rating assigned thereto corresponding to the source format of the received file (see Morimoto, column 8, lines 3-13).

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Morimoto's teachings of an information processing apparatus connected to a network to translate a document with the teachings of Appleby, for the purpose of proving a more efficient way of translating documents into a suitable format by a client system.

4. As per claim 2, Appleby-Morimoto teaches the conversion format is readable by the client computer, and further wherein the selected server is capable of converting the received file written in the source format into the received file written in the conversion format (figures 1, column 13, lines 20-36).

5. As per claim 6, Appleby-Morimoto discloses the use of different operating system for two different computers where one is a server and the other is a client is inherent. (Windows).

6. As per claims 7, 18, 35 and 37, Appleby-Morimoto teaches transmitting to the selected server the received file written in the source format unreadable by the client computer, receiving from the selected server the received file written in a conversion format readable by the client computer, wherein the received file written in the source format is converted by the selected server into the received file written in the conversion format, and displaying the received file written in the conversion format, and displaying the received file written in the conversion

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format on the client computer using a native application on the client computer (figures 1, 18 and 21, column 4, lines 49-56, column 13, lines 31-43).

7. As per claims 12 and 36, Appleby-Morimoto teaches transmitting to the selected server the received file written in the source format unreadable by the client computer, and receiving from the selected server a location of the received file written in a conversion format readable by the client computer, wherein the received file written in the source format is converted by the selected sewer into the received file written in the conversion format (figures 1, 2, 24-29, column 5, lines 27-56, column 8, lines 3-13).

8. As per claim 13, Appleby-Morimoto teaches directing a web browser application on the client computer to the location of the received file written in the conversion format on the selected server; and downloading the received file written in the conversion format from the selected server onto the client computer using the web browser application (figures 1, 2, 6, column 1 , lines 17-20, 35-42).

9. As per claims 14 and 33, Appleby-Morimoto teaches the URL and IP address (figures 1, and 2, column 5, line 50).

10. As per claims 8, 15, 29 and 32, Appleby-Morimoto teaches the HTML format (figure 7, column 8, lines 25-44).

11. As per claims 5, 22 and 25, Appleby-Morimoto teaches locating the entry in the lookup table corresponding to the source format of the received file; and selecting the server included in the located entry of the lookup table (figures 1, 2, 7, 12, 14 and 15).

12. As per claim 28, Appleby-Morimoto teaches receiving contact information for the selected server from the resource locator server (figure 1, column 4, lines 49-60).

13. As per claim 30, Appleby-Morimoto teaches selecting one of the plurality of servers having the highest conversion rating assigned thereto corresponding to the source format of the file archive, transmitting a location of the file archive on the Internet to the selected server; receiving from the selected server an index page including a plurality of links, each link corresponding to one of the plurality of files in the file archive written in a conversion format readable by the client computer, wherein the file archive written in the source format is converted by the selected server into the file archive written in the conversion format, and displaying the index page on the client computer (figures 1, 18 and 21 column 4, lines 49-56, column 8, lines 3-13, column 13, lines 31-56).

14. As per claim 23, Appleby-Morimoto teaches equipment for coupling to the network, wherein the client computer is capable of intermittently connecting to at least one of the plurality of sewers through the network; and a computer program stored on the memory and capable of being executed by the processor, wherein the program is capable of performing the steps of receiving a file on the client computer, wherein the file is written in a source format unreadable by the client computer', and selecting one of the plurality of servers having the highest conversion rating assigned thereto corresponding to the source format of the received file (figures 1, 18 and 21 column 4, lines 49-56, column 8, lines 3-13, column 13, lines 31-56).

Claim Rejections - 35 USC § 103

15. Claims 9, 10, 16, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appleby-Morimoto as applied to claims 1, 7, 12, 30 above, and further in view of Lau et al. (Lau), U.S. Patent No. 6,832,380.

16. As per claims 9, 10, 16 and 31, Appleby-Morimoto discloses the invention substantially as claimed. However, Appleby-Morimoto does not teach the source format being a compressed format and the conversion format for the file being decompressed format.

17. In the same field of endeavor, Lau discloses the source format being a compressed format and the conversion format for the file being decompressed format (see Lau, figures 5, 12, column 5, lines 42-56).

18. Thus, it would have been obvious to one skill in the art to combine Morimoto's conversion with Lau's compress/decompress format in order to centralize client administrative tasks and provide metering to monitor client/server execution of application programs.

Claim Rejections - 35 USC § 103

19. Claims 11, 17, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appleby-Morimoto and Lau as applied to claims 1, 7, 12, above, and further in view of Miura et al. (Miura), U.S. Patent No. 6,862,103.

20. As per claims 11 and 17, Appleby-Morimoto and Lau does not teach the source format being an encrypted format and the conversion format for the file being decrypted format. However, Miura teaches it in column 6, lines 15-21. Thus, it would have been obvious to one skill in the art to combine Morimoto's conversion with Miura's encryption/decryption format in order to prevent client requests from waiting too long before reaching the server or from not reaching the server at all by selecting a network route for reply data of the server, which is

different from that for request data.

21. As per claim 19, Appleby-Morimoto and Lau teaches selecting one of the plurality of sewers having the highest conversion rating assigned thereto corresponding to the source format of the file archive; transmitting a location of the file archive on the Internet to the selected server; receiving from the selected server an index page including a plurality of links, each link corresponding to one of the plurality of files in the file archive written in a conversion format readable by the client computer, wherein the file archive written in the source format is converted by the selected server into the file archive written in the conversion format, and displaying the index page on the client computer (figures 1, 18 and 21 column 4, lines 49-56, column 8, lines 3-13, column 13, lines 31-56). Morimoto does not teach the source format being an encrypted format and the conversion format for the file being decrypted format. However, Miura teaches it in column 6, lines 15-21.

22. Thus, it would have been obvious to one skill in the art to combine Morimoto's conversion with Miura's encryption/decryption format in order to prevent client requests from waiting too long before reaching the server or from not reaching the server at all by selecting a network route for reply data of the server, which is different from that for request data.

Claim Rejections - 35 USC § 103

23. Claims 3, 4, 21, 24, 27, 34, 38-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appleby-Morimoto as applied to claims 1, 20, 23, 26, above, and further in view of Toyoda, U.S. Patent No. 6,880,019.

24. As per claims 3 and 27, Appleby-Morimoto discloses the invention substantially as claimed. However, Appleby-Morimoto does not teach MIME.

25. However, Toyoda teaches MIME (see Toyoda, column 5, line 35).

26. Thus, it would have been obvious to one skill in the ad to combine Morimoto's conversion with Toyoda's MIME in order to perform an image reception using a communication protocol, which needs an IP address for a receiver side, in accordance with, for example, a DHCP protocol in the network in which an IP address is assigned to a communication terminal from an outer section.

27. As per claims 4, 21, 24, 34 and 39, Morimoto teaches selecting one of the plurality of servers having the highest conversion rating assigned thereto corresponding to the source format of the received file (column 8, lines 3-13). Morimoto is silent with respect to receiving a file on the client computer, wherein the file is written in a source format unreadable by the client computer. However, it is inherent that if a computer does not possess the resource/software/programs to recognize a file it will be unreadable to the computer. Morimoto teaches the client requests the server to retrieve information concerning entries, which do not exist on the client, and executes a translation (figure 1, column 4, lines 49-56). Moreover, Morimoto teaches the client side recognizes a portion, which cannot be translated such as an unknown word by using a dictionary and a grammar and also issues a retrieval request a translation knowledge such as dictionary information to the dictionary server (column 13, lines 31-36). Morimoto does not teach the broadcasting. However, Toyoda teaches it in the abstract.

28. Thus, it would have been obvious to one skill in the ad to combine Morimoto's

conversion with Toyoda's broadcast in order to perform an image reception using a communication protocol, which needs an IP address for a receiver side, in accordance with, for example, a DHCP protocol in the network in which an IP address is assigned to a communication terminal from an outer section.

29. As per claim 38, Appleby-Morimoto and Lau teaches selecting one of the plurality of sewers having the highest conversion rating assigned thereto corresponding to the source format of the file archive, transmitting a location of the file archive on the Internet to the selected server, receiving from the selected server an index page including a plurality of links, each link corresponding to one of the plurality of files in the file archive written in a conversion format readable by the client computer, wherein the file archive written in the source format is converted by the selected server into the file archive written in the conversion format; and displaying the index page on the client computer (figures 1, 18 and 21 column 4, lines 49-56, column 8, lines 3-13, column 13, lines 31-56). Morimoto does not teach the source format being a compressed format and the conversion format for the file being decompressed format.

However, Lau teaches it in figures 5, 12, column 5, lines 42-56. Thus, it would have been obvious to one skill in the art to combine Morimoto's conversion with Lau's compress/decompress format in order to centralize client administrative tasks and provide metering to monitor client/server execution of application programs.

30. As per claim 40, Morimoto teaches equipment for coupling to the network, wherein the client computer is capable of intermittently connecting to at least one of the plurality of sewers through the network; and a computer program stored on the memory and capable of

being executed by the processor, wherein the program is capable of performing the steps of: receiving a file on the client computer, wherein the file is written in a source format unreadable by the client computer', and selecting one of the plurality of servers having the highest conversion rating assigned thereto corresponding to the source format of the received file (figures 1, 18 and 21 column 4, lines 49-56, column 8, lines 3-13, column 13, lines 31-56). Morimoto does not teach the broadcasting.

31. However, Toyoda teaches it in the abstract. Thus, it would have been obvious to one skill in the art to combine Morimoto's conversion with Toyoda's broadcast in order to perform an image reception using a communication protocol, which needs an IP address for a receiver side, in accordance with, for example, a DHCP protocol in the network in which an IP address is assigned to a communication terminal from an outer section.

32. As per claims 41 and 42, it is inherent that if a computer does not possess the resource/software/programs to recognize a file it will be unreadable to the computer. Morimoto teaches the client requests the server to retrieve information concerning entries, which do not exist on the client, and executes a translation (figure 1, column 4, lines 49-56). Moreover, Morimoto teaches the client side recognizes a portion, which cannot be translated such as an unknown word by using a dictionary and a grammar and also issues a retrieval request a translation knowledge such as dictionary information to the dictionary server (column 13, lines 31-36).

Response to Arguments

33. Applicant's arguments filed June 2, 2006 have been fully considered but they are not persuasive. The applicants argued in substance that:

A) "it appears that the rejection is based upon an interpretation of a user being unable to understand the language of selected text with the claim 1 requirement of a file having 'a source format unreadable by the client computer'. However, nothing in the referenced portion of the Appleby patent would lead one of ordinary skill in the art to understand that the client computer referenced in Appleby is *unable to read* the file that is being sent to the Appleby system. While the user of the client may not be able to understand the language of the text stored in the file, this does not mean that the file containing the text is 'in a source format unreadable by the client computer', as required by claim 1."

As to point A, the examiner respectfully disagrees. The purpose of the Appleby system is to translate a document in a format that it is able to read. A format that is not consistent with the required language is deemed to be unreadable. For instance, unless the client computer is specifically equipped to understand a foreign language, it will not be able to decipher the alphanumeric text that is received. Therefore, it must request a server to translate that document into a form understandable by the client system.

B) "claim 1 requires that 'the file is written in a *source format unreadable by the client computer*', while the Morimoto system addresses a situation in which the text of a document on the Internet is written in a language that is not the *user's* language. The Morimoto patent is not concerned with whether the file format of the Internet document is readable by the Morimoto system – clearly the document must be readable by the system or the system could not attempt to

translate the language of the document -- but rather is simply concerned with accessing dictionaries when an "unknown" word 'that cannot be translated' is encountered in the document."

As to point B, the applicants' arguments are not persuasive. Morimoto was relied upon for selecting a server having the highest conversion rating, not, as suggested by applicants, to be concerned with documents whose source formats are unreadable. As to applicant's arguments here against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The purpose of the combination of Morimoto was merely for the selection of a server for optimal conversion.

Conclusion

34. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H. Kang whose telephone number is (571) 272-3882. The examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



PAUL H. KANG
PRIMARY PATENT EXAMINER